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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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KATTEN MUCHIN ROSENMAN LLP 525 WEST MONROE STREET CHICAGO, IL 60661-3693			EXAMINER NGUYEN, STEVEN H D	
			ART UNIT 2616	PAPER NUMBER

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/803,905

Applicant(s)

SNELGROVE ET AL.

Examiner

Steven HD Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27-105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-105 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 27-48 and 52-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owen (WO 9807282) in view of O'Brien (WO 9729443).

Regarding claims 27-30, 33, 36-38, 41-42, 52-55, 58, 61-63, 69-72, 75, 78-80, 86-90, 93 and 96-98, Owen discloses a telecommunication system comprising a first user interface (Fig 3, Ref 1101) and a second user interface (Fig 3, Ref 1102) interconnected by a telecommunications network (Fig 3, Ref 1100); said first user interface connected to at least one computer processor and electronic memory means for executing a first set interface's requirements for communicating with said second user programming code that determines said first user interface (Fig 3, Ref 1140); said at least one computer processor and electronic memory means operable to

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execute a third set of programming code that manages negotiations between said first set of programming code and said second set of programming code, said negotiations for determining terms of communication between said first user interface and said second user interface through said network, said negotiations based on a trusted negotiating discipline (Fig 9 the program codes negotiates a connection between the first and second user interface based on a trusted negotiating profile, See Page 16, lines 3-12, Page 18, lines 20-30, Page 22, lines 7-16, Page 31, line 25 to Page 32, line 12, Page 40, lines 12-30 and Page 3, line 17 to Page 7, line 24) is selectable by a user of said first user interface from a plurality of negotiating disciplines (Fig 7) and a single network software agent (Fig 9). However, Owen fails to disclose said telecommunication network connected to said at least one computer processor and electronic memory means for executing a second set of programming code that determines available network resources of said network. In the same field of endeavor, O'Brien discloses a system for telecommunication network connected to said at least one computer processor and electronic memory means for executing a second set of programming code that determines available network resources includes presently available network resource of said network to be use in the negotiation with a user interface and sever based on the trusted rule and selectable by a user of said first user interface from a plurality of negotiating disciplines (Fig 5, Ref 51, 52, Page 2, lines 8-24); requirements include the available hardware resources of said first user interface (Page 2, line 1, bandwidth); a single network software agent (Fig 5) and the available hardware resources of said requirements second user interface for executing application ((Page 2, line 1, bandwidth requires for executing the application on the server).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system for determining the network resource for using in the negotiating between the program codes as disclosed by O'brien into the system and method of Owen. The motivation would have been to increase the services for network and improve the quality of signal.

Regarding claims 31, 56, 73, 91, Owen discloses said application comprises voice telephony (Page 1, lines 18-25).

Regarding claims 40, Owen discloses said second user interface is connected to a computer processor and an electronic memory means for executing a fourth set of programming code that determines said second user interface's requirements for communicating with said first user interface; and said third set of programming code for further managing said negotiations so as to include said fourth set of programming code (Fig 9).

Regarding claims 43, 45, 65, 82, 100, Owen discloses said communication comprises voice telephony (Page 1, lines 18-25).

Regarding claims 46, 66, 83, 101, Owen discloses said network comprises an ATM network (Page 10, lines 12-18).

Regarding claims 32, 44, 57, 74, 92, Owen and O'brien fail to disclose requirements include the costs that are to be assessed first user interface during said communication. However, the examiner takes an official noticed that a method and advantage for the requirement includes a cost for negotiating is well known and expected in the art at the time of invention was made. Therefore, it would have been obvious to one of ordinary skill in the art to implement a

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cost in the requirement of the request during communication into a system of Owen and O'brien.

The motivation would have been to provide a lowest cost communication.

Regarding claims 34, 59, 76, 94, Owen and O'brien fail to disclose said available network resources include a cost of the network resources to be consumed during said communication. However, the examiner takes an official noticed that a method and advantage for determining a total cost for communicating between the users is well known and expected in the art at the time of invention was made. Therefore, it would have been obvious to one of ordinary skill in the art to implement a total cost for communicating between the users into a system of Owen and O'brien. The motivation would have been to provide a customer with a billing on the fly.

Regarding claims 35, 60, 77, 95, Owen and O'brien fail to disclose a prediction of network usage during said communication. However, the examiner takes an official noticed that a method and advantage for a prediction of network usage during said communication is well known and expected in the art at the time of invention was made. Therefore, it would have been obvious to one of ordinary skill in the art to implement it into the system of Owen and O'brien. The motivation would have been to prevent a congestion such as an overbook.

Regarding claims 39, 64, 81, 99, Owen and O'brien fails to disclose set programming code is implemented as multiple network software agents, each network software agent being respective to a different telecommunication service provider. However, the examiner takes an official noticed that a method and advantage for second set programming code is implemented as multiple network software agents, each network software agent being respective to a different telecommunication service provider are well known and expected in the art at the time of

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invention was made. Therefore, it would have been obvious to one of ordinary skill in the art to implement it into the system of Owen and O'brien. The motivation would have been to reduce cost for user.

Regarding claims 47, 67, 84, 102, Owen and O'brien fail to disclose said negotiating discipline includes at least one of a round robin, bid-and-ask, bluffing, poker and a reverse auction. However, the examiner takes an official noticed that a method and advantage for using at least one of a round robin, bid-and-ask, bluffing, poker and a reverse auction in the negotiating process is well known and expected in the art. Therefore, it would have been obvious to one of ordinary skill in the art to implement it into the system of Owen and O'brien. The motivation would have been to reduce cost for user.

Regarding claims 48, 68, 85, 103, Owen fails to disclose said negotiating discipline terminates said negotiation if said negotiations fail to reach an agreement within a predetermined period of time (Fig 7 and 8).

Regarding claim 104, Owen discloses said negotiation comprises initiating said communication (Page 18, lines 20-29 and Fig 12).

Regarding claim 105, Owen and O'brien fail to fully disclose said communication is ongoing and said negotiation is for modifying terms of an said existing communication. However, the an examiner takes an office notice that this method is well known and expected in the art for renegotiating the parameters during the communication between the first and second users. The motivation would have been to support multimedia network between the users.

3. Claims 49-51 rejected under 35 U.S.C. 103(a) as being unpatentable over Gell (USP 6577858) in view of Owen (WO 9807282).

Regarding claim 49, Gell discloses a computer-implemented method for negotiating terms of communication between a first user interface (Fig 7, Ref 12) and a second user interface (Fig 7, Ref 12) connected by a telecommunications network (Fig 7, Ref 60), said method comprising the steps of receiving, from a first set of programming code associated with said first user interface, an offer for said terms offer including said of communication, said first user interface's first user interface's requirements for communicating with said second user interface through said network (Fig 17, Receive codes, See col. 17, lines 1-22); verifying said first user interface's offer conforms with a trusted negotiation discipline; presenting said first user interface's offer to a second set of programming code associated with said network if said first user interface's offer conforms with said discipline (See col. 17, lines 29-45); receiving from said second set of programming code, another offer for said terms of communication, said another offer including at least said network's available resources for said communication, and including a modification of said first user receiving, from said second set of interface's offer; returning said another offer to said first set of programming code discipline; said another offer conforms with said repeating the foregoing steps if said offers conform with said discipline; and (Col. 17, lines 47-65). However, Gell fails to discloses an counter offer. In the same field of endeavor, Owen discloses a method and system for terminating the offer or counteroffer fails to meet the requirement and notifying the offer or counter offer to the first and second program code (See Fig 8 and 9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system for terminating the offer or counteroffer fails to meet the requirement and notifying the offer or counter offer to the first and second program



code as disclosed by Owen into a system and method of Gell. The motivation would have been to improve the throughput of the network.

Regarding claim 50, Gell discloses trusted negotiating discipline first user interface from a plurality selectable by a user of said of negotiating disciplines (col. 17, lines 17-4).

Regarding claim 51, Gell discloses said requirements include the available hardware resource (Col. 17, lines 29-47, price per byte, frame, packet).

### ***Response to Arguments***

4. Applicant's arguments filed 3/14/06 have been fully considered but they are not persuasive.

5. In response to applicant's argument that O'brien is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Owen discloses a method and system for negotiating a call setup between the parties based on user profiles. O'Brien discloses a method and system for negotiating with another agent to form a contract for a telecommunication company via communication network. So, O'brien clearly discloses a method and system for negotiating a contract between a provider and client of telecommunication network In order to allocate the resource for the client in order to meet the SLAs of the client.

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the

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teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art or the nature of the problem to be solved. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Owen discloses a method and system for negotiating a call setup between the parties based on user profiles. O'Brien discloses a method and system for negotiating between the provider and client in order to allocate the resource for the client. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system for determining the network resource for using in the negotiating between the program codes as disclosed by O'Brien into the system and method of Owen. The motivation would have been to increase the services for network and improve the quality of signal.

7. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to page 26, the applicant states that O'Brien and Owen fail to disclose a means for determining available network resources. In reply, Owen disclose a user has a allocated resource which allocated by the service provider (it's implicitly disclosed a means for

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determining available network resource before allocating the resource to a user) during the session. O'brien discloses a module for negotiating between a client and service provider, wherein the service provider determines the available resource and comparing with SLA before allocating it to the client (Pages 1, line 32 to page 2, line 2 states that to setup an overall service the components may have its own availability requirement such as communication bandwidth. So, it's clearly disclose a means for determining available bandwidth, See page 2, lines 8-24). Furthermore, the applicant states does not disclose the programming codes for negotiating between the parties. In reply, Owen discloses a service provider which allocates the resource for a session. So it's obvious to one of ordinary skill in the art to recognize that a service provider has a programming code to negotiate between the parties based on the user files that stored at the service provider as set forth in the final office action, Sec 2. O'brien discloses a module for using to negotiate between the clients and service provider, wherein the service provider determines the available network before allocating the resource in order to meet the SLA of the clients (Pages 1, line 32 to page 2, line 2 states that to setup an overall service the components may have its own availability requirement such as communication bandwidth. So, it's clearly disclose a means for determining available bandwidth, See page 2, lines 8-24). Therefore, the teaching of Owen and O'brien disclose the program codes wherein the second program code is used to determine the available of network before allocating the bandwidth for client in order to meet their SLA.

In response to page 27, the applicant states that "negotiating discipline" is different from negotiating strategy of the parties. In reply, the negotiating strategy reads on the negotiating

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discipline because it's a set of rules that parties must be agreed before allocating resource for a communication session.

In response to applicant's argument in pages 27-29 that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gel discloses a method and system for negotiating between a call and the provider about a price of a call by bidding, auctioning etc. Owen discloses a method and system for negotiating between clients and provider in order to provide the resource for communication session between the clients by using proposal and counter offer. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system for terminating the offer or counteroffer fails to meet the requirement and notifying the offer or counter offer to the first and second program code as disclosed by Owen into a system and method of Gell. The motivation would have been to reduce the cost of the communication session.

In response to pages 29-30, the applicant states that the prior arts fail to disclose "receiving, from ... including a modification of said first user interface's offer". In reply, Gell discloses that a user receives another offer that includes price "term communication" and quality of services "available network" and includes modifying the price and Qos of the first user interface's offer by performing a several negotiations. For examples, the first user send a request

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“offer of first user interface” to service provider, the service provider replies another offer which includes term, available bandwidth which is different from the first user request. Furthermore, Owen discloses a method and system for negotiating between the devices by performing several offer and counter offers between devices until the devices agree with conditions that presents in the proposal by modification the data in the proposal. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., modification of said first user receiving, from said second set of interface's offer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (571) 272-3159. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571) 272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Steven HD Nguyen  
Primary Examiner  
Art Unit 2616  
June 6, 2006